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Serial No. 10/667,770

REMARKS

Claims 1-16 remain pending in this application and are rejected. Claims 1 and 13 have been amended herein to incorporate the structural limitations of claim 16; claim 16 is cancelled herein. Claims 4 and 11 are amended herein to clarify the invention.

Claims 1, 8 and 13-16 have been rejected under 35 U.S.C. 103(a) as obvious over Ikoma et al. (U.S. Patent No. 5,663,007). The Office Action states on page 5 that Ikoma fails to disclose that the projecting ridges extend all the way to the top of the case where the opening is found. The Office Action states that it would have been an obvious matter of design choice to extend the projecting ridges to the opening.

The applicants respectfully traverse the rejection for failing to establish a *prima facie* case of obviousness and, alternatively, aver that the claims as amended overcome the case of obviousness.

As is stated in the MPEP, the Federal Circuit holds that "a prior-art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention." See MPEP §2141.02 VI citing *W.L. Gore & Associates v. Garlock Inc.*, 721 F.2d 1540 (Fed. Cir 1983). Furthermore, the Supreme Court has held that "teaching away" is an indication of nonobviousness. See *U.S. v. Adams*, 383 U.S. 39. Furthermore, MPEP §2143

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states that "[t]o establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Ikoma specifically teaches that the projecting ridges do not extend all the way to the top of the case, in order to provide "welding regions". See Col. 5, lines 1-2. Ikoma further specifies that any protrusion from the welding region should be ground down to provide as smooth an area as is practical. See Col. 5, lines 15-16. Ikoma goes into great detail, including figures illustrating the manufacture of the battery with the "welding regions." See Col. 5, lines 1-2, Figures 7-8, Col. 6 line 36 - Col. 7 line 20. In so specifying, Ikoma teaches away from having projecting ridges that extend all the way to the top of the case where the opening is found. Therefore, it is clear that there is not only no motivation to make such a design change there is suggestion and motivation from the prior art not to have projecting ridges that extend to the top of the cell case.

In contrast, the present application discloses that when welding along the side it may be done "between the projecting ridges." See Specification page 7 second paragraph. Furthermore, Ikoma's welding regions are along the side of the of the battery case. Claims 1 and 13, as amended with the structural limitation of claim 16, have "welding portions" that are along "the positive and negative electrode faces" on the end faces of the battery. Thus, a *prima facie* case of obviousness is not established because the cited reference does not teach or suggest ridges that extend to the top of the battery or welding portions on the end faces of the battery.

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Claims 5, 10, 11, and 12 have been rejected under 35 U.S.C. 103(a) as obvious over Ikoma in view of Asahina et al. (U.S. Pre-Grant Publication No. 2003/0027040). Claims 2, 3, 4, 6, 7, 9, and 11 have been rejected under 35 U.S.C. 103(a) as obvious over Ikoma in view of Asahina and Masuda et al. (U.S. Patent No. 4,865,932).

The Office Action states on page 4 that Ikoma does not disclose that the cells have an electrode projection on the bottom plate. The Office Action states that Asahina teaches one electrode at the top of each cell and another at the bottom, and that it would be obvious to combine the electrode configuration of Asahina with the cell of Ikoma.

MPEP §2143 states that “[t]o establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” The MPEP also states that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” Furthermore, “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The applicants respectfully traverse the rejection for failing to establish a *prima facie* case of obviousness.

Ikoma has projecting ridges on the individual battery cells “for placing the cells in butted

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relation to each other" and these projecting ridges "are longitudinally arranged in parallel [to] each other." See Col. 4 lines 59-62. Ikoma teaches that projecting ridges should be placed on the sides of a cell that will abut another cell. Therefore, when combining Ikoma and Asahina, the ridges would have to be where the cells abut, which in Asahina would be on the top or bottom of the individual battery cells, where the electrodes are placed and not along the sides. Thus, the combination of the two does not result in ridges on the sides of the casing where the cells do not abut. Furthermore, if the cited references were combined so as to have the projecting ridges along the sides of the battery module and not between the cells, then the projecting ridges would be rendered unsatisfactory for their intended purpose of providing space between cells for air to flow and cool the cells. See Ikoma Abstract.

Furthermore, there is motivation *not* to combine Ikoma and Asahina, i.e. with the protrusions along the sides of the cells where the cells abut each other. Such protrusions would increase the distance between the cells, thereby increasing the current carrying path, and Asahina specifically states that one of the advantages of the invention is that the current carrying path is shortened between cells. See Asahina Para. 14. Thus, a *prima facie* case of obviousness is not established because the cited references do not teach or suggest projecting ridges along the sides of the battery module or cell where there are no connection projections and there is motivation *not* to combine the cited references.

In light of the foregoing, the application is now believed to be in proper form for

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allowance of all claims and notice to that effect is earnestly solicited.

Applicants respectfully request a three month extension of time for responding to the Office Action. The fee of \$1,020 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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